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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,373	07/11/2001	Terry Lynn Cole	5500-58300	1646

7590

01/21/2004

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EXAMINER

MASON, DONNA K

ART UNIT	PAPER NUMBER
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DATE MAILED: 01/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/904,373

Applicant(s)

COLE ET AL.

Examiner

Donna K. Mason

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The disclosure is objected to because of the following informalities:

On page 3, line 15, change "method an" to --method and--;

On page 8, line 6, change "Bus interface 25" to --Bus interface 28--;

On page 10, line 9, change "the may" to --that may--;

On page 10, lines 20-21, the phrase "This information." constitutes an incomplete statement. It is recommended that this phrase be deleted;

On page 12, line 1, change "EPROM 24" to --EPROM 31--;

On page 12, line 15, insert --24-- after "host controller";

On page 19, line 16, change "base upon" to --based upon--.

Appropriate correction is required.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD AND APPARATUS FOR
CONFIGURING A PERIPHERAL BUS.

Claim Objections

3. Claims 24 and 25 objected to because of the following informalities:

Claim 24 is identical to dependent claim 23. It is recommended that dependent claim 24 be cancelled.

Claim 25 recites "an addition peripheral device" in line 3. It appears "addition" should be changed to --additional--.

Appropriate correction is required. See 37 CFR 1.75.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "a peripheral bus" in both lines 1 and line 2. It is unclear whether the peripheral bus recited in line 2 refers to a different peripheral bus from that recited in line 1. It is recommended that "a peripheral bus" in line 2 be change to --the peripheral bus--.
7. Claim 1 recites the limitation "peripheral information" in 7. There is insufficient antecedent basis for this limitation in the claim. It is recommended that "peripheral information" be changed to --configuration information--. (It should be noted that for examination purposes, claim 1 has been interpreted using the recommended changes).
8. Dependent claims 2-13 inherent the deficiencies of independent claim 1.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 and 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22 and 23 of U.S. Patent No. 6,671,748 to Cole, et al. in view of U.S. Patent No. 4,933,845 to Hayes.

Claims 22 and 23 of U.S. Patent No. 6,671,748 disclose a method including the steps of querying a peripheral bus, determining the presence of a peripheral device, and reading configuration information, where a step of configuring includes programming the peripheral device to use one or more timeslots, and where the steps of querying, determining, reading, and configuring are performed by a host controller coupled to the peripheral bus. U.S. Patent No. 6,671,748 does not expressly disclose the step of configuring the bus, as recited in independent claim 1 of the examined application.

Hayes discloses the step of configuring the bus (column 1, lines 5-9). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the step of configuring a bus in Hayes with U.S. Patent No. 6,671,748. The suggestion or motivation for doing so would have been to provide a means of communication with either external memory or external input/output, such as an additional processor or peripheral devices (column 1, lines 5-9).

Therefore, it would have been obvious to combine Hayes with U.S. Patent No. 6,671,748 to obtain the invention as specified in claims 1 and 2.

11. Claims 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,671,748 to Cole, et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claim 14 is generic to the computer system in claim 10 of U.S. Patent No. 6,671,748. Furthermore, claim 10 of U.S. Patent No. 6,671,748 falls entirely within the scope of examined claim 14. More specifically, because the computer system of claim 10 in U.S. Patent No. 6,671,748 is a species of the generic category defined by the computer system of the examined claim 14, the computer system of claim 14 is anticipated by claim 10 of U.S. Patent No. 6,671,748.

12. Applicant is advised that should claim 23 be found allowable, claim 24 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

13. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,012,103 to Sartore, et al. ("Sartore") in view of U.S. Patent No. 4,916,692 to Clarke, et al. ("Clarke").

With regard to claims 1-3, 14, and 15, Sartore discloses a method including the steps of querying a peripheral bus (column 1, lines 55-66), determining the presence of a peripheral device (column 1, lines 55-60), and reading configuration information (columns 1 and 2, lines 66-67 to lines 1-3), where the steps of querying, determining, reading, and configuring are performed by a host controller coupled to the peripheral bus (column 1, lines 55-60). Furthermore, Sartore discloses that the peripheral bus is a serial bus (column 1, lines 39-40).

With regard to dependent claims 4-8 and 16-20, Sartore discloses the configuration information including "one or more" of the characteristics enumerated in claims 4 and 16, where the clocking information includes a determination of whether a peripheral clock is a master clock or a slave clock, where the configuration information is passed from the peripheral device to the host controller, and where the reading is performed over a side serial bus (column 2, lines 43-45 and column 4, lines 24-30). Sartore also discloses the host controller reading device identification information from the peripheral device, and obtaining additional configuration information from a lookup table (column 1, lines 66-67 to column 2, lines 1-3).

With regard to dependent claims 9 and 21, Sartore discloses storing the configuration information in a serial erasable programmable read-only memory (EPROM) (column 4, lines 21-23).

With regard to dependent claims 10-13 and 22-25, Sartore discloses the use of stream addressing, the identification information including vendor identification and function of the peripheral device, and plug and play compatibility, and querying,

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determining, reading, and configuring additional peripheral devices coupled to the peripheral bus (column 2, lines 32-67 to column 3, lines 1-35).

Sartore does not expressly disclose the step of configuring the bus, where the configuring includes programming the peripheral device to use one or more timeslots, as recited in independent claims 1 and 14. Clarke discloses the step of configuring the bus, where the configuring includes programming the peripheral device to use one or more timeslots (column 1, lines 47-68 to column 2, lines 1-39). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the step of configuring a bus in Clarke with Sartore. The suggestion or motivation for doing so would have been to optimize versatility and speed in communications over the bus (column 1, lines 11-13).

Therefore, it would have been obvious to combine Clarke with Sartore to obtain the invention as specified in claims 1-25.

Conclusion

14. A shortened statutory period for reply is set to expire THREE MONTHS from the mailing date of this communication. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna K. Mason whose telephone number is (703) 305-1887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

DKM


XUAN M. THAI
PRIMARY EXAMINER
